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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/756,257	11/25/96	SCHELLENBERG	J PII3248

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QM41/1016 7

EXAMINER
MANTIS MERCADER, E

ART UNIT	PAPER NUMBER
3737	6

DATE MAILED: 10/16/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/756,257

Applicant(s)
Schellenberg

Examiner
Eleni Mantis Mercader

Group Art Unit
3737



☒ Responsive to communication(s) filed on Jul 29, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17, 19-31, and 33-35 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 24 is/are allowed.

☒ Claim(s) 1, 2, 4-17, 19-23, 25, 26, 28, 29, 31, and 33-35 is/are rejected.

☒ Claim(s) 3, 27, and 30 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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FINAL ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-2, 4-17, 19-23, 25-26, 28-29, 31, 33-35 have been considered but are moot in view of the new ground(s) of rejection. The additions to the claims of means of determining an actual position of the means for indicating and the at least one indicator providing to a human operator an indication render the applicant's arguments moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-2, 4-15, 26, 28, 31, 33-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Barrick.

Regarding claims 1, 26 and 28, Barrick teaches an apparatus for guiding the movement of a surgical tool in relation to the anatomy of a patient (col. 2, lines 19-23), the apparatus

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means for determining
comprising means for indicating to a human the difference between the actual and desired positions of the tool (fluoroscope, col. 2, lines 34-36) and means for determining the actual position of the means for indicating (optical digitizer, col. 6, lines 1-5).

Regarding claim 2, the tool is characterized by a tool reference frame and the difference is indicated with respect to the tool reference frame (col. 6, lines 13-23).

Regarding claims 4-15, 31 and 33-35, the means for indicating comprises at least one indicator, the indicator indicating the direction in which the tool should be moved to reach the desired position; wherein the at least one indicator provides an indication of the distance the tool should be moved to reach the desired location; and wherein the at least one indicator is a light emitting diode and the at least one indicator is characterized by an indicator reference frame (group of LEDs on fluoroscope); and wherein the at least one indicator is mounted to a patient support (LEDs on fluoroscope) (col. 6, lines 1-23).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17, 19-23 and 25 rejected under 35 U.S.C. 102(b) as being anticipated by

Cartmell.

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Cartmell teaches the use of a surgical tool having a plurality of infrared emitters mounted on the tool and at least one human readable position indicator mounted on the tool to indicate the direction the tool should be moved to reach a desired position and wherein the position indicator comprises an LCD display and the indicators are arranged along perpendicular lines (col. 4, lines 14-66).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrick in view of Bucholz of record.

Regarding claim 16, Barrick teaches the use of LEDs on the means for indicating (fluoroscope, col. 2, lines 28-30). Barrick does not teach the use of audible indication. Bucholz in the same field of endeavor teaches the use of audible indication (col. 6, lines 8-21). It would have been obvious to one skilled in the art at the time the invention was made to have used audible indication as opposed to LEDs as an alternative well known functional equivalent in the field of stereotaxy.

8. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrick.

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Barrick does not teach the use of blink rate or color of an indicator visible to a user. It would have been obvious to one skilled in the art at the time the invention was made to have modified Barrick's indicators to use the blink rate and color mechanism as an alternative use of visual indication which are functional alternatives well known in the field of stereotaxy.

Allowable Subject Matter

9. Claims 3, 27 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claim 24 is allowed.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hirschi et al. teach a tube placement verifier system.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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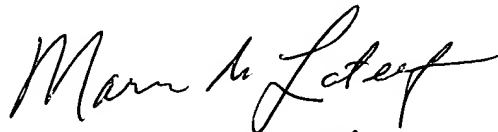
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is (703) 308-0899. The examiner's supervisor, Mr. Marvin Lateef, can be reached on (703) 308-3256.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. The fax phone number for this group is (703) 308-3590.



EMM
October 12, 1998.



Marvin M. Lateef
Supervisory Patent Examiner
Group 3700